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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/27/2000

Paul C. Daly

4538US

6751

24247

7590

07/11/2003

TRASK BRITT

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EXAMINER

WEINSTEIN, STEVEN L

ART UNIT

PAPER NUMBER

1761

DATE MAILED: 07/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/670781

Applicant(s)

DALY

Examiner

S. WEINSTEIN

Group Art Unit

1761

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

☒ Responsive to communication(s) filed on 7/15/02

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

☒ Claim(s) 1-7, 10, 12-20 is/are pending in the application.

Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-7, 10, 12-20 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some\* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

☐ Copies of the certified copies of the priority documents have been received

in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other \_\_\_\_\_

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lazure et al ('207) in view of Blass et al (2/91), Stevens et al (Jan/Feb. 1999), Stevens et al (1997), and Franck (2000), further in view of Beckers ('746), and Hendriks et al ('242) for the reasons fully and clearly detailed in the Office action mailed 3/13/02, Paper No. 6.

Claim 1 now recites that the container has a greater width than depth and the solution comprises 10-50% sucrose which recitations were previously found in claims 9 and 11, respectively and were addressed previously.

Claims 12-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blass et al (2/91), in view of Stevens et al (Jan/Feb. 1999), Stevens et al (1997), and Franck (2000), further in view of Lazure et al ('207), Beckers ('746), and Hendriks et al ('242), also for the reasons fully and clearly detailed in the Office action mailed 3/13/02, Paper No. 6.

All of applicant's remarks filed July 15, 2002, Paper No. 7 have been fully and carefully considered but are not found to be convincing.

It is urged that there is no suggestion or motivation in the references to arrive at applicant's invention. This urging is totally unconvincing. The motivation comes from

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the art taken as a whole. The art taken as a whole teaches it was notoriously old to provide foods and medicinals in general in single serve cup shaped containers, and it was notoriously old to provide foods and medicinals in aseptic packages and it was well known to provide a sterile sucrose solution in the recited concentration as an analgesic for newborns, and it was known to administer the sterile sucrose solution in very small amounts. These teachings, or evidence, are all within the art, taken as a whole. Since the art taken as a whole teaches it was well established to provide medicinals in single serve cup shaped containers and since the recited sterile sucrose solution is conventional and known for its use as an analgesic, to package the conventional sterile sucrose solution in the conventionally recited concentration in a conventional single serve cup shaped container, for its art recognized and applicants intended function, and for the well known advantages derived from single serve cup shaped packages would have been unequivocally obvious. It is urged that this evidence is not sufficient to establish obviousness. This is not convincing as shown above. The only teaching that is perhaps missing from the art taken as a whole is if one reference taught packaging the sucrose solution in the cup shaped container, but then the rejection would be under 35 USC 102, anticipation, not 35 USC 103, obviousness. It is the art taken as a whole that would fairly lead one to package the conventional product in a conventional container. Applicant has combined a number of conventional expedients and a product and employed the conventional expedients for their well known and intended function and

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achieved no new or unexpected result therefrom. In regard to claim 12, it is urged that claim 12 recites discarding any residual solution after the planned medical procedure. It is first noted in this regard, that the claim recites discarding any residual solution so that if there is no residual solution, none would be discarded, so that a reference would not have to teach discarding. That is, as recited, the claim is similar to reciting a range of a substance from 0 to some amount – i.e. it is positively present or it is not. In any case, Lazure et al discloses it is conventional to provide unit doses of medicine. That is, it is a packaged dose for a patient. If the patient does not require the entire dose, for whatever reason, the natural thing to do would be to discard the remainder of the dose. This is no different than a fast food restaurant's handling of their single serve condiments containers. Restaurants do not collect single serve containers if they have only been partially used and recycle them to other customers; they discard them.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication from the examiner should be directed to Steven Weinstein whose telephone number is (703) 308-0650. The examiner can generally be reached on Monday-Friday from 7:00 a.m. to 3:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (703) 308-3959. The fax phone numbers for the organization where this application is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0661.

S. Weinstein/dh  
July 9, 2003

  
STEVE WEINSTEIN  
PRIMARY EXAMINER 1761  
2/10/03